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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/612,935  | 07/07/2003  | Masayuki Ikeno       | 239863US0 CIP       | 6629             |
| 22850   | 7590        | 04/20/2005           | EXAMINER            |                  |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | ROBERTSON, JEFFREY  |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1712                |                  |
| DATE MAILED: 04/20/2005   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/612,935

Applicant(s)

IKENO ET AL.

Examiner

Jeffrey B. Robertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 9-13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 10/044,983.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 0703,0803.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 10 is objected to because of the following informalities: For claim 10, in line 2, ester is spelled incorrectly. Also, there is a period in the middle of line 4 that should be deleted. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8 are rejected under 35 USC 102(b) as being anticipated by Inoue et al. (U.S. Patent No. 4,485,206).

For claims 1 and 7, Inoue teaches compositions containing 100 parts by weight of a diorganopolysiloxane terminated with hydroxyl groups having a degree of polymerization (corresponding to applicant's n) of at least 5, 0.5 to 30 parts of an organosilane having at least three hydrolyzable groups, and 0.1-20 parts by weight of an organic sulfur compound. Col. 1, line 45 through col. 2, line 4. For claims 1 and 6, Inoue teaches the presence of a curing catalyst that includes titanium chelates. Col. 5, lines 6-14 and 64.

For claims 2 and 3, Inoue discloses that the diorganopolysiloxane contains alkyl groups and that the viscosity is preferably between 1000-100,000 centistokes. Col. 2,

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lines 11-52. The viscosity range appears to be consistent with n values between 100 and 1000.

For claim 4, Inoue teaches that the hydrolyzable groups on the organosilane include alkoxy groups. Col. 3, lines 41-64.

For claims 5 and 8, Inoue teaches that the sulfur compound is tetraethylthiuram disulfide.

4. Claims 1-8 are rejected under 35 USC 102(b) as being anticipated by Favre et al. (U.S. Patent No. 4,529,749).

For claims 1-7, Favre teaches compositions containing 100 parts by weight of a diorganopolysiloxane having hydrocarbon groups terminated with hydroxyl groups having a viscosity of 700-1,000,000 mPa.s, 0.5 to 30 parts of an organosilane having at least three hydrolyzable groups (including alkoxy groups), 0.0003 to 15 parts of a curing catalyst that includes titanium chelates, and 0.01 to 1.2% of a tetralkylthiuram disulfide. Col. 2, lines 10-67. The viscosity range appears to be consistent with n values between 100 and 1000.

For claim 8, Favre teaches that the sulfur compound is tetraethylthiuram disulfide. Col. 8, lines 47-48.

5. Claims 1-7 are rejected under 35 USC 102(b) as being anticipated by Onishi et al. (U.S. Patent No. 4,973,644).

For claims 1-7, in Example 1, Onishi teaches compositions containing 100 parts by weight of a diorganopolysiloxane having hydrocarbon groups terminated with alkoxy

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groups having a viscosity of 15,000 centipoise, 5 parts of methyltrimethoxysilane, 1.5 parts of a curing catalyst that is a titanium chelate, and 1 part by weight of mercaptopropylalkoxysilanes. The viscosity range appears to be consistent with n values between 100 and 1000. In column 7, lines 7-14, Onishi teaches an example where the alkoxy-terminated polysiloxane of Example 1 is replaced with the corresponding hydroxyl-terminated dimethylpolysiloxane. This composition anticipates applicant's claims. The mercaptosilanes set forth by Onishi are not excluded by claim 1 of the instant application.

#### ***Allowable Subject Matter***

6. Claims 9-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. For claims 9-13, the prior art cited above is the closest prior art. None of those references teaches or suggests the particular sulfur containing organic compounds set forth in claims 9-13.

#### ***Conclusion***

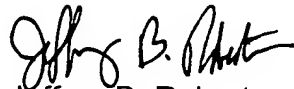
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brooks et al. (U.S. Patent No. 3,318,763), Itoh et al. (U.S. Patent No. 4,201,698), and Liang (U.S. Patent No. 4,797,448) are cited for general interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jeffrey B. Robertson  
Primary Examiner  
Art Unit 1712

JBR